



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/089,327 | 03/27/2002 | Katsuyuki Watanabe | WIP008 | 1305 |
| 25271 | 7590 | 03/18/2005 | EXAMINER | |
| GALLAGHER & LATHROP, A PROFESSIONAL CORPORATION 601 CALIFORNIA ST SUITE 1111 SAN FRANCISCO, CA 94108 | | | LEE, EDMUND H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1732 | |

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/089,327 | WATANABE ET AL. | |
| | Examiner | Art Unit | |
| | EDMUND H. LEE | 1732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 3-8 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>247704 3/27/02</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____ . |

GB

DETAILED ACTION

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said...liquid-phase state" (cl 3, ln 6) is indefinite because it is confusing and idiomatically incorrect.

The phrase "by forming...resin" (cl 3, lns 6-8) is indefinite because it is unclear how the above phrase results in the formation of the colored region.

Claim 3 is indefinite because performance of the claimed steps does not produce a colored shaped article. All that is formed is one layer.

Claim 4 is indefinite because performance of the claimed steps does not produce a colored shaped article. All that is formed is one layer.

Art Unit: 1732

The phrase "by curing" (cl 4, ln 5) is indefinite because it is unclear what is being cured.

The phrase "the contour line" (cl 4,ln 5) lacks antecedent basis in the claim.

The phrase "a liquid-phase region" (cl 4, ln 7) is indefinite because it is unclear whether or not it is related to the curable resin.

The phrase "said colored region" (cl 4, ln 8) lacks antecedent basis in the claim.

The phrase "a prescribed amounts" (cl 6, ln 2) is idiomatically incorrect.

Correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4,5,6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Penn et al (USPN 5594652). Penn et al teach the claimed process as evidenced at col 6, lns 55-65 and figs 1-17d.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Penn et al (USPN 5594652). In regard to claim 3, Penn et al teach the basic claimed process including a process for producing a colored shaped article comprising a plurality of layers formed by lamination and shaping of a curable resin, wherein at least one layer of the plurality of layer has a first region and a colored region formed by adding a colorant (col 6, Ins 55-65; figs 1-17d); forming the colored region (col 6, Ins 55-65; figs 1-17d); and curing the liquid-phase, curable resin (col 6, Ins 55-65; figs 1-17d). Penn et al, however, do not teach forming the colored region so that it can be recognized from all directions; and forming a non-colored region. In regard to forming the colored region so that it can be recognized from all directions, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature of the claimed process. Further, colored portions within a transparent material are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a colored region having the claimed design in the process of Penn et al in order to form an aesthetically pleasing article. In regard to forming a non-colored region, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature of the claimed process. Further, non-colored molded articles are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill

Art Unit: 1732

in the art at the time the invention was made to form a non-colored region in the article of Penn et al in order to enhance the aesthetic appeal of the article.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Penn et al (USPN 5594652). The above teachings of Penn et al are incorporated hereinafter.

Penn et al, however, do not teach adding the colorants in the claimed sequence. The claimed sequence is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed sequence is well-known in the molding art in order to achieve a specific color. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the colorants of Penn et al in a specific sequence in order to achieve a specific color.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US patents illustrate the state of the art: 5278442 and 6165406.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL


3/7/04